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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/057,998      | 01/29/2002  | Naoshi Matsuo        | 1359.1061           | 3115             |

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EXAMINER

HALIM, SAHERA

ART UNIT PAPER NUMBER

2157

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/057,998

Applicant(s)

MATSUO, NAOSHI

Examiner

Sahera Halim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/28/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in respond to communication filled on January 29, 2002.
2. Claims 1-11 are pending in the application.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 3 recites the limitation "where it is" in line 2. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 7 recites the limitation "there are" in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. The term "as well as " in claim 6 is a relative term which renders the claim indefinite. The term "as well as " is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.  
The claimed invention of claim 11 is directed to non-statutory subject matter. Claim 11 is claiming a program which is not tangible. The claim is not limited to statutory subject matter and is therefore non-statutory.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 – 11 are rejected under 35 U.S.C. 102(e) as being anticipated by US. Pat. No. 6,609,106 to Robertson (hereinafter Robertson).

10. Regarding claim 1, Robertson teaches an information providing system, comprising: one or a plurality of user terminals (Fig. 1, numeral 50); a service providing server for providing service to the user terminal (Fig. 1, numeral 60, IS); and an information brokering server for brokering information on contents of service provided by the service providing server to the user terminal, wherein the information brokering server comprises (Fig. 1 numeral 70, Gift Registry Service):

an information brokering part for receiving an information search request from the user terminal, and brokering corresponding information to the user terminal in accordance with the search request; and a user access information control part for notifying the service providing server of user access information generated by evaluating contents of access to the information brokering server by a user, based on

an information search action by the user and contents of information brokered to the user (Fig. 30 and 41 and col. 18, line 34 – 45 and col. 19, lines 50 – 60; user sends search request and receives content of gift registry), and

the service providing server comprises: an incentive adjusting part for adjusting contents of an incentive to be given to the user based on the user access information notified from the information brokering server, in a case of receiving an information providing request from the user of the user terminal (col. 13, lines 1-35); and

an executing part for receiving the information providing request from the user and executing service in accordance with the information providing request according to the contents of the incentive (col. 13, line 1-35, incentive is modified according to the number of participating users).

11. Regarding claim 2, Robertson teaches an information providing system according to claim 1, wherein the information brokering server further comprises:

an information browsing environment detecting part for detecting information on an information browsing environment of the user terminal (col. 20, line 65 – col. 21, line 30); and

an information editing part for editing information provided by the service providing server based on the information on the information browsing environment detected by the information browsing environment detecting part (col. 22, line 1- 29),

wherein the information brokering part brokers the information edited by the information editing part to the user terminal (col. 22, lines 30 – 41).

12. As to claim 3, Robertson teaches an information providing system according to claim 2, wherein, in a case where it is detected from the information on the information browsing environment that text information can be presented at the user terminal, the information editing part conducts edition of incorporating banner advertisement in a part of the information provided by the service providing server (col. 13, line 1 – 34).

13. Reference to claim 4, Robertson teaches an information providing system according to claim 1, wherein the user access information control part in the information brokering server evaluates the contents of access to the information brokering server by the user, considering an information search history of the user and contents of user information included in the search request by the user (col. 18, line 34 – 57 and col. 22, line 59 – col. 23, line 18).

14. Regarding claim 5, Robertson teaches an information providing system according to claim 1, wherein the information brokered to the user terminal in the information brokering server contains main information and sub-information, the main information is retrieved based on the information search request from the user, and the sub-information is not retrieved based on the information search request from the user (col. 18, line 34 – 57 and col. 22, line 59 – col. 23, line 18).

15. Reference to claim 6, Roberson teaches an information providing system according to claim 5, wherein, in a case where the user notifies the service providing server of an information providing request regarding the sub-information as well as an information providing request regarding the main information, the incentive adjusting part adjusts the contents of the incentive to be given to the user, based on the user access information and the information providing requests regarding the main information and the sub-information (col. 13, line 1-35).

16. Regarding claim 7, Roberson teaches an information providing system according to claim 5, wherein there are a plurality of the information brokering servers, the main information corresponds to an information search request from the user, and the sub-information is provided by a service providing server other than a service providing server that provides the main information (col. 18, line 34 – 57 and col. 22, line 59 – col. 23, line 18, and Figs. 30 and 41).

17. As to claim 8, Roberson discloses an information providing system according to claim 1, wherein the incentive adjusting part adjusts the contents of the incentive to be given to the user, based on the user access information and an information providing request history of the user (col. 13, line 1-35).

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18. Reference to claims 9, 10 and 11, claims 9 –11 are rejected under the same rationale as claim 1. Although claims 9 – 11 are not identical to claim 1, they do not further teach or differ over the limitations of claim 1.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,815,665 to Teper et al.

U.S. Pat. No. 6,085,230 to Ryuutou et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (571) 272-4003. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

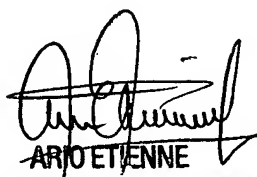


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim  
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AU: 2157

June 2, 2005

  
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